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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/710,334

07/01/2004

David S. Bonalle

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04/10/2006

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EXAMINER

WALSH, DANIEL I

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 04/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/710,334	<b>Applicant(s)</b> BONALLE ET AL.	
	<b>Examiner</b> Daniel I. Walsh	<b>Art Unit</b> 2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 December 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. Receipt is acknowledged of the RCE received on 28 December 2005.

#### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 1-5 and 9-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Black (US 2005/0122209) in view of Sawaguchi (US 6,931,538).

Re claims 1, 12, and 14, Black teaches a method for registering biometric information for use in a smartcard system; the method comprising: detecting a proffered biometric at a sensor to obtain a proffered biometric sample; verifying the proffered biometric sample; storing the

proffered biometric sample; and associating the proffered biometric sample with a smartcard such that the smartcard system utilizes the proffered biometric sample to authorize a smartcard payment utilizing the smartcard (FIG. 5A, paragraphs [0016, 0028, 0030-0046, and 0083]. The Examiner notes the card can have an associated account/value that is used to make payment for the transaction. As the card and sample is used for a purchase/financial transaction, it is interpreted to include associating it with a smartcard for transactions. Though Black is silent to storing on a database, the Examiner notes that databases are well known and conventional means for storing and organizing stored data. It would have been obvious to use a database to store the data in an efficient and organized way for retrieval.

Black is silent to associating the biometric with a preset transaction limitation and that the smartcard payment is authorized in compliance with the preset transaction limitation.

The Examiner notes that it is well known and conventional that credit cards have transaction limitations (such as maximum amount/credit line). Specifically, Sawaguchi teaches that the card identification number/biometric is verified and also the price of a commodity is checked to be within the limit amount of a transaction (S46-S47). The Examiner notes that such credit limits are well known and conventional in the art to control spending provide security in case of theft, etc. Additionally, the Examiner notes that other such credit limits such as the maximum amount available per purchase, number of transactions in a time period, etc. are also well known means for enhancing security with a card.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Black with those of Sawaguchi.

One would have been motivated to do this in order to set limits on purchases for security, for example. The Examiner notes that the biometric/fingerprint is used to authenticate a user for a transaction, where the card/transponder/user has a transaction limit, as discussed above. The Examiner has interpreted such teachings as a biometric being associated with a transaction limitation, because the biometric is used to authenticate a user for a transaction, where the transaction has a limitation on it, so the biometric is seen as being associated with the transaction limitation, as part of the process.

Re claim 2, the Examiner notes that detection/associating/processing of the sample is a part of detecting/sensing/receiving the sample.

Re claim 3, the Examiner notes that as the samples are stored in a user file/computer/on the transponder/card itself, it is interpreted as logging (paragraph [0027], for example).

Re claim 4, Black teaches detecting/associating/processing one additional proffered biometric sample, through the capture of the signature (FIG. 5A).

Re claim 5, FIG. 5A teaches determining if the fingerprint is legible. This is interpreted as one of processing, comparing and verifying the sample.

Re claim 9, it has been discussed above re claim 5, to verify a sample. Though silent to specifically using a local CPU/third party vendor to do so, the Examiner notes it would have been obvious to use a local CPU/third party to do so, as a well known and conventional means to process data for verification.

Re claim 10, though Black is silent to using a secondary security procedure to verify the sample, the Examiner notes that such means are well known and conventional in the art (body

heat measurement, blood flow, etc.), and one would have been motivated to use such a procedure to ensure only legitimate samples are accepted (reduce fraud, for example).

Re claim 11, as discussed above the sample can be stored locally or remotely. Though silent to a database, it would have been obvious to use a database as a means to organize and store data for retrieval.

Re claim 13, Black teaches (FIG. 1A for example) that the host computer can store the reference data. The Examiner has interpreted the host computer as biometric information registered with at least one of a third party biometric security vendor and a government agency. The Examiner notes that as the transactions can take place remotely, it is obvious that the host computer can be such a party (for example the card/fob company the user registered with) as a means for securely providing the biometric information to facilitate a transaction at a point of sale terminal, for example.

3. Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Black/Sawaguchi, as discussed above, in view of Robinson (as cited in the previous Office Action).

Re claims 6-8, the teachings of Black/Sawaguchi have been discussed above.

Black/Sawaguchi is silent to verifying including comparing a proffered biometric sample with a stored biometric sample (one of a criminal, terrorist, and cardmember).

Robinson teaches a system for biometric authorization for transaction processes. Specifically, Robinson teaches that during the enrollment process, customer data (interpreted to include biometric data) is compared to a data already registered in the central database for uniqueness (paragraph [0057]). Accordingly, this is interpreted as comparing a proffered

biometric with a stored biometric. The Examiner notes that the stored biometric can be one of a criminal, terrorist, or cardmember, since the comparison is performed to reduce multiple enrollments or reduce fraud/alert fraudulent enrollments. Re claim 8, Robinson teaches the customer data is compared to that on central database 204.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Black with those of Robinson.

One would have been motivated to do this in order to increase security.

### *Conclusion*

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Brundage et al. (US 2005/0160271), Uberti (US 2003/0046237) which teaches recording and logging of transaction details, Jensen et al. (US 2005/0165684) which teaches that purchases above a limit can be authenticated using at least two of a password and a voice/fingerprint, and Nambiar et al. (US 2002/0128977) which teaches secondary transaction numbers.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel I. Walsh whose telephone number is (571) 272-2409. The examiner can normally be reached on M-F 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel I Walsh

Examiner

Art Unit 2876

3-2006

A handwritten signature in black ink, appearing to read 'D. Walsh', with a long, sweeping horizontal stroke extending to the right.